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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,763	06/06/2000	Robert A. Law	F-160	9261

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 07/25/2003

*Final Amendment Due 25 OCT 03*

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/588,763

Applicant(s)

LAW, ROBERT A.

Examiner

Akiba K Robinson-Boyce

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Status of Claims***

1. Due to communications filed 5/14/03, the following is a final office action.  
Claims 1-18 are pending in this application and have been examined on the merits.  
Claims 5 and 14 have been amended. Any amendments made to the claims have been reflected in the office action. The previous office action has been maintained. Claims 1-18 have been rejected as follows.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8-10, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al (US 5,754,939) as cited by applicant.

As per claims 1, 10, Herz et al discloses:

A web server in operative communication with a plurality of recipients and a plurality of senders, (Col. 28, lines 52-66, where the recipients are represented by the users or individuals with personal computers, the senders are represented by the

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information servers, and the web server is provided by America Online which provides data connection service with the selected ones of the information servers) the plurality of senders desirous of generating messages intended for the plurality of recipients, respectively; (Col. 30, lines 32-38 and lines 58-60, Col. 36, lines 22-26, where the user represents the recipient and the information server represents the sender);

The web server includes a plurality of recipient preference profiles corresponding to the plurality of recipients, respectively, and a plurality of sender profiles corresponding to the plurality of senders/storing a plurality of recipient preference profiles...(Abstract, lines 8-10, where the "target profile interest summary" for each user represents the recipient preference profile, Col. 6, lines 1-7, where the profile information that describes the users' interests represents the recipient preference profiles and the profile information that describes the target object characteristics represents the sender profiles);

Each of the recipient preference profiles includes respective information directed to the recipient's preferences for receiving messages, (Col. 5, lines 21-25, where the respective information is represented by the target profile interest summary which includes a set of individual search profiles);

The web server provides the plurality of senders with access to the plurality of recipient preference profiles/providing the plurality of sender with access to the plurality of recipient...(Col. 5, lines 48-50, where the user's target profile interest summaries which represent the recipient preference profiles is accessible by the servers [senders]);

The web server maintains a relationship between the log of recipient preference

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profiles out of the plurality of recipient preference profiles that have been accessed by a particular sender/maintaining a relationship...(Col. 47, line 66-Col. 48, line 3, where the relationship is represented by the tabulation);

For each of the recipient preference profiles in the log of recipient preference profiles, the web server provides a change notification to the particular sender of a change in the recipient preference profile, (Col 48, lines 3-6, where the change notification is represented by the summary which enables the proxy server to update the user's target profile interest summary and user profile, Col. 63, lines 50-58, where it is shown that a user of the system is notified of the new target objects determined by the user's target profile interest summary via e-mail or fax).

As per claims 8, 17, Herz et al discloses:

Each of the recipient preference profiles includes respective interest data (Col. 1, lines 25-27, where the respective interest data is represented by the description of the user's interest level in various types of target objects);

each of the sender profiles includes respective industry description data and (Col. 10, lines 1-24, where the industry relates to the movie industry);

when a new recipient establishes a new recipient preference profile, the web server provides a new recipient notification to those senders whose industry description data matches the new recipient's interest data, (Col. 37, lines 8-63, esp. lines 25-30 and lines 55-64, where the unique pseudonym relates to and is used when a user requires a new pseudonym for use with a provider and the new recipient notification is represented by the presentation to the service providers).

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As per claims 9, 18, Herz et al discloses:

The new recipient notification of industry description data match is in accordance with instructions provided in the plurality of sender profiles, respectively/providing the new recipient notification of industry, (Col. 34, lines 32-41, where access control instructions accessed by the server represents the instructions provided in the plurality of sender profiles).

***Claim Rejections - 35 USC § 103***

4. Claims 2-7, 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (US 5,754,939) as cited by applicant.

As per claims 2, 11, Herz et al does not specifically disclose the following:

The web server notifies the particular sender in a format specified in the particular sender's sender profile...

Official notice is taken that it is old and well known in the data communication art to send data in a specified format. It would have been obvious to one of ordinary skill in the art to transmit data in a specified format with the motivation of successively transmitting this information. In addition, the Herz et al patent discloses that users access the information servers via electronic mail, which utilizes an industry standard format. Since an industry standard format is used in this case, the industry standard format serves as a universal format and is therefore already specified for the sender. It

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is also common practice in Internet messaging to set up profiles with respect to data transmission and how the data will be transmitted.

However, Herz et al does disclose that

As per claims 3, 12, Herz et al discloses:

Each of the recipient preference profiles includes respective interest data, (Col. 1, lines 25-27, where the respective interest data is represented by the description of the user's interest level in various types of target objects);

Each of the sender profiles includes respective industry description data, (Col. 10, lines 1-24, where the industry relates to the movie industry);

When a new recipient establishes a new recipient preference profile, the web server provides a new recipient notification to those senders whose industry description data matches the new recipient's interest data, (Col. 37, lines 8-63, esp. lines 25-30 and lines 55-64, where the unique pseudonym relates to and is used when a user requires a new pseudonym for use with a provider and the new recipient notification is represented by the presentation to the service providers).

As per claims 4, 13, Herz et al discloses:

The new recipient notification of industry description data an interest data match is in accordance with instructions provided in the plurality of sender profiles, respectively, /providing the new recipient notification of industry description data, (Col. 34, lines 32-41, where access control instructions accessed by the server represents the instructions provided in the plurality of sender profiles).

As per claims 5, 14, Herz et al discloses:

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Each of the recipient preference profiles includes respective no interest data; and, if a given sender accesses one of the plurality of recipient preference profiles and the given sender's industry description data matches the one of the plurality of recipient preference profiles no interest data, then the web server provides a listing of other senders whose industry description data matches the one of the plurality of recipient preference profiles interest data, (Col. 20, lines 46-58, where the no interest data is represented by no topical interest, Col. 65, lines 33-40, where the "next-best" alternative labels represents the listing of other senders).

As per claims 6, 7, 15, 16, Herz et al discloses:

For each of the recipient preference profiles the web server associates a listing of those of the plurality of senders that have accessed the recipient preference profile; and, the web server utilizes this listing in generating the change notifications, (Col. 79, lines 22-34, where the list, that identifies at least one of the identified ones of the plurality of target objects and sets of target object characteristics represents the listing of those of the plurality of senders where the plurality of senders are represented by target objects, Col. 63, lines 50-58, where the list is formed by correlating the user target profile interest summaries, therefore the list is no more than a target profile interest summary; and the change notifications are determined through the evaluation of a user's target profile interest summary).



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***Response to Arguments***

5. Applicant's arguments filed 5/14/03 have been fully considered but they are not persuasive.

As per claims 1 and 10, the applicant argues that Herz fails to disclose "a log of recipient preference profiles...accessed by a particular sender". However, Herz discloses this limitation in Col.5, lines 48-50 where the user's target profile interest summaries are described as being accessible to the relevant server. In this case, the servers perform matching of target objects to users, and also give the user control over the ability of third parties to access the object and contact the user (See abstract, lines 21-25). Therefore, the server acts as the sender of information via a third party entity.

In addition, the applicant argues that claims 1 and 10 fail to disclose "the web server provides a change notification to the particular sender of a change in the recipient preference profile". However, Herz discloses this limitation in Col. 48, lines 3-6. Here, it is disclosed that when the proxy server changes access information for a user, a summary of this information is transmitted to the proxy server, which has a user base according to the user profile, and the proxy server then updates the user's target profile interest summary and the user profile for a particular user. In this case the proxy server represents the sender. In addition, Herz discloses that users may request access while navigating on the World Wide Web in Col. 41, lines 5-10. Therefore, it is inherent that a Web server handles the communication such as "providing change notification" to the proxy server since the communication is in a Web environment.

As per claims 8 and 17, the applicant argues that Herz fails to disclose "provides

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a new recipient notification to those senders whose industry description data matches the new recipient's interest data". However, in Col. 10, lines 1-24, it is disclosed that attributes are stored about each target object. In this case, the attribute information comprises data relating to a movie and the industry is therefore represented by the movie industry. As described above with respect to claims 1 and 10, Herz discloses that when access information for a user is changed by the proxy server, a summary of this information is transmitted to the proxy server, which has a user base according to the user profile, and the proxy server then updates the user's target profile interest summary and the user profile for a particular user. In this case the proxy server represents the sender. Because of this, the user with particular attributes (which in this case relates to the movie industry) who is interested in data described in the user's target summary will have his new recipient or target data sent to his sender.

As per claims 9 and 18, the applicant argues that Herz fails to disclose "instructions provided in the plurality of sender profiles". However, Herz discloses control instructions that represent a particular user and performs bi-directional routing of commands and target objects (See Col. 34, lines 32-45).. Since these instructions are associated with a particular pseudonym and a particular user, this indicates that the instructions are meant for a particular user using a particular pseudonym. In addition, these control instructions are retrieved from the user's target profile interest summary and each proxy server (sender) maintains an encrypted target profile interest summary associated with each allocated pseudonym.

As per claims 2-7 and 11-16, these claims are unpatentable by the cited

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references for at least the reasons stated above with reference to independent claims 1 and 10 and are rejected for the same reasons.

As per claims 2 and 11, the applicant argues that the references are not properly combined and that there is no motivation to combine Herz '939 with a profile chosen notification format. However, in order to successively transmit information in a system that relates to customized electronic identification of desirable objects (Herz), a profile chosen notification format is necessary. In addition, the Herz et al patent discloses that users access the information servers via electronic mail, which utilizes an industry standard format. Since an industry standard format is used in this case, the industry standard format serves as a universal format and is therefore already specified for the sender. It is also common practice in Internet messaging to set up profiles with respect to data transmission and how the data will be transmitted.

As per claims 3 and 12, the applicant argues that Herz fails to disclose "new recipient notification to ...senders". However, as described above with respect to claims 8 and 17, Herz discloses this feature in Col. 10, lines 1-24.

As per claims 4 and 13, the applicant argues that Herz fails to disclose "instructions provided in the plurality of sender profiles: in providing "news recipient information". However, as described above with respect to claims 9 and 18, Herz discloses this feature in Col. 34, lines 32-45.

As per claims 5 and 14, the applicant argues that Herz fails to disclose "provides a listing of other senders whose industry description data matches the...recipient preference profiles interest data". However, Herz discloses this feature in Col. 10,

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lines 1-24 along with Col. 12, lines 10-17. In this case, Herz describes a system that allows a user to list documents that link to a document in a certain industry, which is in this case, the movie industry.

As per claims 6, 7, 15 and 16, the applicant argues that Herz fails to disclose "a listing of ...senders that have accessed the recipient preference profile". However, Herz discloses this feature in Col. 79, lines 22-34, where the list, that identifies at least one of the identified ones of the plurality of target objects and sets of target object characteristics represents the listing of those of the plurality of senders where the plurality of senders are represented by target objects. In addition, Herz discloses that the list is formed by correlating the user target profile interest summaries in Col. 63, lines 50-58. Therefore the list is no more than a target profile interest summary; and the change notifications are determined through the evaluation of a user's target profile interest summary.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238

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[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications],  
and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is 703-305-3900.

*ARB*

A. R. B.

July 17, 2003

*Romain Janty*  
*Art Unit 3623*